

REMARKS

I. Amendments

By this amendment, claims 1, 12-14, 18, 21 and 22 have been amended and claims 8, 16, 19, 20 and 23 have been canceled.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

Typographical errors have been corrected in the specification.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "Version with Markings to Show Changes Made".

No change of inventorship is necessitated by this amendment.

II. Discussion of the Restriction Requirement

Claims 1-23 have been subjected to a restriction requirement. Applicants have previously elected a single species for examination. Unfortunately, that species does not fall within the Examiner's current Group I designation which Applicants assume had been intended for covering the elected species. In the subsequent paragraphs, Applicant provide information to assist the Examiner understanding of the scope of their claims, and the relationship of the main independent claims to the elected species.

As a visual aide to the Examiner's understanding of the invention, and the relationship of the elected species to Formula I, Applicants have created Figures 1 and 2, provided as attached Appendix B. In Figure 1, the elected species previously submitted to the Examiner is presented and divided up to show what portions of the molecule are equivalent to the alphabetical

identifiers in Formula I. Applicants believe that this visual representation will clarify the Examiner's misunderstanding.

In addition to the visual aide, Applicants wish to state on for record that the Examiner's current restrictions of Y, DEGZ and R¹ are inconsistent with the elected species.

Specifically, the DEGZ identifiers of Formula I are not biphenyl. As can be seen from Figure 1, the biphenyl group which the Examiner noticed actually belongs to R¹.

Moreover, Y in the elected species is two hydrogen atoms, not O or S as in Group I.

Therefore, Applicants submit that the elected species would not be found in the Examiner's current Group I, but rather must be within the undefined Group II, which is everything else. Therefore, Applicants hereby elect Group II with traverse.

In order to advance prosecution, Applicants have amended their claims in accordance with the elected species, and with a view to provide a structure having a fixed backbone which the Examiner can readily search. To this end, Applicants have narrowed the definitions of D, E and G in independent claims 1, 18, 21 and 22; and in dependent claim 14. As can be seen in Figure 2, the more specific definitions of D, E and G fixes the identity of a portion of the generic structure, providing a common core. These limitations add no new matter to the specification, as will be demonstrated in the following paragraphs.

By this amendment, D has been limited to "an optionally substituted divalent hydrocarbon group" in claims 1, 18, 21 and 22 in accordance with page 26, lines 12-13 of the specification.

Also by this amendment, E has been limited to "-CO(R^a)-", as disclosed in claim 8 *inter alia*.

Additionally by this amendment, G has been limited to "an optionally substituted divalent hydrocabon group" as disclosed in claim 12 *inter alia*.

Applicants respectfully submit that they have complied with the restriction requirement by electing Group II, and limiting the pending claims accordingly.

III. Discussion of the Rejection of Claim 23 under 35 U.S.C. Sec. 101

Claim 23 has been rejected under 35 U.S.C. Sec. 101 as an improper use claim. By this amendment, Applicants have cancelled claim 23 and therefore request withdrawal of the 35 U.S.C. Sec. 101 rejection of claim 23.

IV. Discussion of the Rejection of Claims 1-23 under 35 U.S.C. Sec. 112, First Paragraph

Claims 1-23 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly non enabled as to the definitions of G, D and R².

By this amendment, the definitions of G and D have been narrowed in claims 1, 14, 18, 21 and 22 as discussed in Section II of this response. Applicants respectfully submit that the more narrow definitions of G and D are enabled. Moreover, Applicants submit that dependent claim 10 as originally filed has an enabled definition of D; and dependent claims 11, 12 and 13 as originally filed have enabled definitions of G.

Examples of R² bonding to an atom on Ring B to form a ring are found in the specification at page 21, line 10 – page 22, line 20 *inter alia*. A synthetic example representative of this ring formation is Example 5, beginning on page 125 of the specification. Applicants submit that this aspect of the invention is therefore sufficiently enabled. Moreover, dependent claims 12 and 13 as originally filed specify compounds wherein R² does not bond to an atom on Ring B to form a ring, which should be outside of the scope of the present rejection with respect to R².

By this amendment, claims 8, 16, 19, 20 and 23 have been cancelled. Claims 2-7, 9-13, 15 and 17 depend upon claim 1. Applicants submit that the more specific dependent claims are also enabled for the reasons provided above.

V. Discussion of the Rejection of Claim 21 under 35 U.S.C. Sec. 112, First Paragraph

Claim 21 has been rejected under 35 U.S.C. Sec. 112, first paragraph. By this amendment, claim 21 has been amended as an independent method of treating claim. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 21.

VI. Discussion of the Rejection of Claim 22 under 35 U.S.C. Sec. 112, First Paragraph

The Examiner has rejected claim 22 under 35 U.S.C. Sec. 112, first paragraph for lack of utility. Applicants respectfully assert that methods for regulating somatostatin receptor function are understood by those skilled in the art as having established utility. Applicants have provided three representative references in attached Appendix A for the Examiner's consideration. In these references, effects of somatostatin regulation and effects of octorectide (a somatostatin analogue) regulation are described. Since a method for regulating somatostatin receptor function with the compounds of the present invention would have a recognizable utility to those skilled in the art, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 22.

VII. Discussion of the Rejection of Claim 16 and 18-22 under 35 U.S.C. Sec. 112, Second Paragraph

Claims 16 and 18-22 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite.

By this amendment, claims 16, 19 and 20 have been cancelled.

Claim 18 has been amended to recite pharmaceutically acceptable carriers, in accordance with the teachings of the specification at page 97, line 22 – page 99, line 10.

Claim 21 has been re-written as an independent method claim. This amendment adds no new matter to the specification. Support for the amendment may be found *inter alia* at pages 101, line 9 – 102, line 4.

Applicants respectfully submit that independent method claim 22 is free of the rejection for indefiniteness.

Therefore Applicants respectfully request withdrawal of the Sec. 112, second paragraph rejection.

VIII. Acknowledgement of Allowability of Elected Species

Applicants wish to acknowledge the Examiner's indication of allowability of the elected species, but request that the elected species be reconsidered and found allowable in light of both the previously submitted Information Disclosure Statement and the Supplemental Information Disclosure Statement which accompanies this response.

IX. Discussion of the Previously Submitted Information Disclosure Statement

Applicants filed an Information Disclosure Statement, Form 1449 and four cited references on April 6, 2001, but they have not received initialled PTO-1449 forms indicating the Examiner's review of the disclosed documents.

Applicants respectfully request the Examiner's consideration of the previously submitted references. If the 1449 or copies of any of the references are missing from the Examiner's file, replacements may be obtained from Applicants' Attorney.

X. Discussion of the Supplemental Information Disclosure Statement

A Supplemental Information Disclosure Statement and four references accompany this response. Applicants respectfully request consideration of these additional references.

XI. Conclusion

Reconsideration of the claims as amended and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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